

FILE COPY



38 1/2  
UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Office of the Solicitor

Pending Litigation Address:  
P.O. Box 15667  
Arlington, Virginia 22215

All Other correspondence:  
Box 8  
Washington, D.C. 20231

August 16, 2004

**Hand-delivered to:**

Jan Horbaly, Clerk  
United States Court of Appeals for the Federal Circuit  
717 Madison Place, N.W.  
Washington D.C. 20439

Re: In re Roy Knowles  
Miscellaneous Docket No. 736

Enclosed, please find for filing, an original and three copies of Director's Response to Knowles' Petition for Writ of Mandamus regarding the above referenced case. Please give me a call at the below number if you have any questions.

Respectfully submitted,

William LaMarca  
Associate Solicitor  
P.O. Box 16116  
Arlington, VA 22215  
(703) 305-9035

*Attorney for the Director*

**IN RE ROY KNOWLES, M.D.,**

**Petitioner.**

**On Petition for Writ of Mandamus**

Misc. Docket No. 767

On June 1, 2004, Petitioner, W. Ray Knowles (“Knowles”) petitioned this Court seeking a writ of mandamus to direct the examiner of his pending patent application, S/N 09/619,142 (142' application), to forward his appeal brief to the Board of Patent Appeals and Interferences (“Board”). On June 15, 2004, this Court issued an Order asking the Director to respond to Knowles’ petition. See June 15, 2004 Order (Attachment 1). The Director submits the following response to this Court’s Order and more importantly, to inform the Court of the recent events that have occurred since the filing of Knowles mandamus petition.

In short, since an examiner's Answer has already been sent, the only thing preventing Knowles' application from being heard by the Board is the filing of his Reply brief, or the passage of the Reply filing deadline, i.e., September 1, 2004. Thus, the current mandamus petition is moot because Knowles must act, or time

must pass, before the appeal before the Board can proceed.

### **BACKGROUND**

On July 19, 2000, Knowles filed the 142' application with the PTO. During prosecution Knowles' application was examined and certain claims were rejected over various references. After receiving a final Office action, Knowles filed an appeal brief to the Board seeking review. However, several interviews, negotiations and claim amendments prompted the examiner to the reopen prosecution and re-examine Knowles' claims. The administrative record reflects that prosecution was re-opened several times as a result of multiple interviews and claim amendments.

#### **1. Knowles' Petition to the USPTO Director**

On March 29, 2003, Knowles' internally petitioned the USPTO Director requesting that his application be forwarded to the Board for review and that prosecution not be reopened again. On May 22, 2003, the USPTO Director rendered a detailed decision reviewing the prosecution history, explaining why prosecution was reopened several times, and instructing Knowles how to put his application in condition for appeal before the Board. See Director's Decision (Attachment 2). In particular, the Director's decision explained that several of the Office actions contained "new ground of rejection" which may have been

“necessitated by applicant’s amendments and or arguments.” See Directors Decision at 2. Further, the Director’s decision explained that:

“although applicant has twice provided an Appeal Brief, the examiner discovered that all the issues were not developed and therefore reopened prosecution. In some instances the new issues related to a new understanding of what was being claimed and how a reference could be applied.”

Id. at 3. Therefore, the Director denied Knowles petition and explained what steps he must take to get his application before the Board. Id. at 3-4 (instructing Knowles to either respond to the last pending Office action or file an Appeal Brief).

## **2. Knowles’ First Mandamus Petition to this Court**

On July 18, 2003, in response to the Director’s decision, Knowles’ filed an appeal brief to the Board. Knowles also simultaneously filed a first mandamus petition in this Court (dated July 15, 2003) arguing that the examiner was attempting to prevent him from submitting an appeal to the Board. Specifically, in his first mandamus petition, Knowles requested that this Court order the USPTO to forward his application to the Board for review. This Court denied Knowles’ first mandamus petition. See July 30, 2003 Order (Attachment 3). In the July 30<sup>th</sup> Order, this Court explained that it reviewed the prosecution history and found that the Director’s internal petition decision was “well explained” and that Knowles

“had to reply to the last office action by either filing an amendment or filing an appeal brief . . .” Id. Further, this Court noted that simultaneously with the filing of Knowles’ first mandamus petition, he also filed an appeal brief to the Board. Id. In support of its denial, this Court explained that mandamus relief was not appropriate because adequate administrative avenues for relief were available to Knowles. See July 30<sup>th</sup> Order at 2 (citing, Mallard v. U.S. Dist. Court for Southern Dist. of Iowa, 490 296, 309 (1989) (A party who seeks a writ bears the burden of proving that it has no other means of attaining the relief desired) and Allied Chemical Corp. v. Daiflon, Inc., 449 U.S. 33, 35 (1980)(the right to issuance of the writ is “clear and indisputable.”)). Further, this Court explained that Knowles’ request to review the merits of his application were wholly inappropriate and also stated that “even if it had mandamus jurisdiction” it could not grant Knowles’ petition. See July 30<sup>th</sup> Order at 2 (citing In re Makari, 708 F.2d 709, 711 (Fed. Cir. 1983)(Federal Circuit’s jurisdiction “in relation to the Patent and Trademark Office is limited to review of decisions of the boards established in that Office” but does not extend to “review decisions of the Commissioner on petitions.”)).

Unfortunately, Knowles’ application is still not in condition to be forwarded to the Board for review because Knowles has not yet filed a Reply to the examiner’s Answer which was mailed over a month ago (i.e., July 1, 2004).

However, as explained below, the PTO bears some responsibility for this delay.

### **3. Events Subsequent to Denial of First Mandamus Petition**

On August 1, 2003, the PTO entered this Court's July 30<sup>th</sup> Order into its internal electronic Patent Application Monitoring System (PALM). The actual entry made into the PALM system reads "Decision by CAFC-Dismissed." See PALM Report (Attachment 4). This PALM entry, "Decision by CAFC-Dismissed," was likely interpreted by internal PTO docketing staff as meaning that this case was terminated, as a PALM entry for any typical "merits appeal" to this Court would be interpreted if it had been dismissed.<sup>1</sup> The apparent misinterpretation by the docketing staff is further supported by a subsequent PALM entry made on March 24, 2004 that reads "Court Processing Terminated." See PALM Report. As a result, Knowles' application never appeared on the examiner's internal PALM docket report since it was likely believed the case was dismissed by this Court. Without the application appearing on her internal docket report, the examiner was not aware that any further action should immediately be

---

<sup>1</sup> Because a petition for mandamus is a rare type of pleading that would be filed at the Federal Circuit with respect to a patent application file before the examiner, the PALM internal docketing system does not currently have the capability to make such an entry, i.e., an entry reading "Petition for Mandamus." Thus, the docketing staff simply used the entries it has available within the PALM system, i.e., "Appeal to CAFC" or "Decision by CAFC-Dismissed." In light of the problem raised in this case, efforts with the PTO's Chief Information Officer are being commenced to add capability to the PALM system allowing for a more descriptive entry for a mandamus petition.

taken on Knowles' application. Accordingly, the examiner was not prompted to send an examiner's Answer to Knowles.

However, on his part, Knowles never contacted anyone at the PTO to check the status of his application. Rather than simply calling the examiner, the supervisory patent examiner (SPE), the Tech Center Director, or the Solicitor to investigate the status of his application, Knowles waited nearly a year and on June 1, 2004, filed the current (second) mandamus petition with this Court, again requesting that his application be forwarded to the Board for review.

### **DISCUSSION**

Once Knowles' second mandamus petition was served upon the PTO, undersigned counsel at the Solicitor's Office, immediately investigated the status of Knowles' pending patent application and found an examiner's Answer was over due. The Tech Center Director was contacted and an examiner's Answer was drafted and mailed in response to Knowles' Board appeal brief. See PALM Report (Answer (June 29, 2004), mailed July 1, 2004). The Solicitor will continue to personally monitor this application until it is transferred to the Board and will make every effort to see that Knowles' appeal will be expedited.

But, Knowles must first file a Reply (or waive his Reply) to the examiner's Answer before his application can be transferred to the Board. See 37 C.F.R.

§ 1.193(b)(1) (“Appellant may file a reply brief to an examiner’s answer. . . within two months from the date of such examiner’s answer.”). Over a month after the mailing of the examiner’s Answer, Knowles has not yet filed a Reply. Therefore, in order to expedite transfer of Knowles’ application to the Board, on August 9, 2004, Knowles was contacted to verify whether he intended to file a Reply to the examiner’s Answer. See Interview Summary (Attachment 5). Knowles indicated that he did intend to file a Reply brief, but not for at least another week. Id. As of the date of this Response (August 16, 2004), Knowles still has not filed a Reply. Thus, at this point, all that is preventing Knowles’ application from being forwarded to the Board, is his filing a Reply brief. See MPEP § 1210 (“The application file and jurisdiction of the application are normally transferred from the Technology Centers to the Board . . . after 2 months from the examiner’s answer, plus mail room time, if no reply brief has been timely filed” or “after the examiner has notified the appellant by written communication that the reply brief has been entered and considered and that the application will be forwarded to the Board”).

Because Knowles has been sent an examiner’s Answer in response to his Board appeal brief, his application will be forwarded to the Board as soon as he files his Reply. Accordingly, the mandamus relief Knowles seeks in his current



petition has already been provided (i.e., an Answer has been sent and upon the filing of his Reply his application will be transferred to the Board for review). Therefore, Knowles's petition for a writ of mandamus is moot.

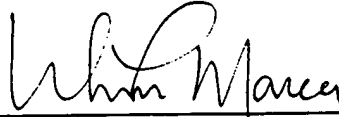
Further, the remaining requests and allegations made in Knowles' petition that relate to the merits of his application will be reviewed by the Board and therefore are premature for this Court to address at this time.

Moreover, because Knowles had previously internally petitioned the USPTO Director on this exact issue, the appropriate reviewing body of this issue is not this Court, but the district court via a civil action pursuant to the administrative procedures act.

Finally, in an attempt assist Knowles, undersigned counsel contacted Knowles' requesting that he withdraw the current mandamus petition in light of the fact that he had been sent and examiner's Answer, but he refused.

This Court should therefore, deny Knowles' petition.

Respectfully submitted,



August 16, 2003

JOHN M. WHEALAN

Solicitor

WILLIAM LAMARCA

EDWARD C. POLK

Associate Solicitors

P.O. Box 15667

Arlington, Virginia 22215

703-305-9035

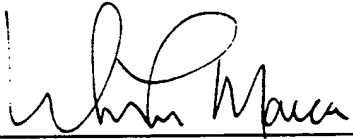
*Attorneys for the Director of the*

*United States Patent & Trademark Office*

CERTIFICATE OF SERVICE

I hereby certify that on August 16, 2004, I caused one copy of the foregoing DIRECTOR'S RESPONSE TO PETITION FOR WRIT OF MANDAMUS to be mailed by United States mail (first-class, postage prepaid), addressed as follows:

J. Mark Pohl, Esq.  
Pharmaceutical Patent Attorneys  
55 Madison Avenue, 4<sup>th</sup> Floor  
Morristown, NJ 07960-7397  
(973) 984-0076

  
\_\_\_\_\_  
William LaMarca  
Associate Solicitor  
P.O. Box 15667  
Arlington, Virginia 22215  
703-305-9035

Attachments

- 1) Order, requiring PTO respond to Current Mandamus Petition (Fed. Cir., June 15, 2004).
- 2) USPTO Internal Petition Decision (USPTO Director, May 22, 2003).
- 3) Order, denying Knowles' First Mandamus Petition (Fed. Cir., July 30, 2003).
- 4) PALM Report of patent application 09/619,142 (printed August 11, 2004).
- 5) Interview Summary from patent application 09/619, 142 (August 9, 2004)



JUNE 15, 2004 ORDER

~~LaMarca/Folk~~

● LICITOR

JUN 21 2004

NOTE: Pursuant to Fed. Cir. R. 47.6, this order  
is not citable as precedent. It is a public order.

U.S. PATENT & TRADEMARK OFFICE

## United States Court of Appeals for the Federal Circuit

MISCELLANEOUS DOCKET NO. 767

IN RE W. ROY KNOWLES, M.D.,

Petitioner.

ON PETITION FOR WRIT OF MANDAMUS

Before RADER, Circuit Judge.

### ORDER

W. Roy Knowles, M.D. petitions for a writ of mandamus to direct the examiner of his patent application to forward Knowles' appeal brief to the Board of Patent Appeals and Interferences.

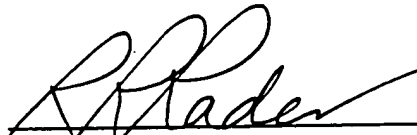
About one year ago, Knowles filed a similar mandamus petition complaining that the examiner was thwarting his attempts to appeal to the Board. In our order denying the mandamus petition, we stated that the Director had informed Knowles of the steps he should take to obtain Board review. He followed those instructions, but now informs us that the examiner has not taken any action.

Upon consideration thereof,

IT IS ORDERED THAT:

The Director is directed to respond within 60 days.

15/6/04  
Date

  
\_\_\_\_\_  
Randall R. Rader  
Circuit Judge

2

**U.S. DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office**

August 16, 2004

(Date)

**THIS IS TO CERTIFY THAT THE ANNEXED IS A TRUE COPY FROM THE  
RECORDS OF THIS OFFICE OF THE FILE WRAPPER AND CONTENTS OF:**

**APPLICATION NUMBER: 09/619,142**

**FILING DATE: July 19, 2000**

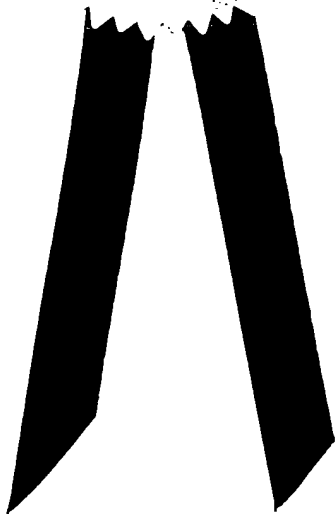
**TITLE OF INVENTION: HAIR LOSS PREVENTION**

**INVENTORS: W. Roy Knowles**

By authority of the  
DIRECTOR OF THE UNITED STATES  
PATENT AND TRADEMARK OFFICE

*Kya E. Abraham*

*Certifying Officer*







UNITED STATES  
PATENT AND  
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY  
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
PO BOX 1450, ALEXANDRIA, VA 22313-1450  
WWW.USPTO.GOV

MAY 22 2003

PHARMACEUTICAL PATENT ATTORNEYS, POHL & ASSOC.  
55 MADISON AVENUE, 4TH FLOOR  
ATTN: MARK POHL (P 4014)  
MORRISTOWN NJ 07960-6397

#30

In re Application of  
W. Roy Knowles  
Serial No.: 09/619,142  
Filed: July 19, 2000  
Attorney Docket No.:

:  
:  
: PETITION DECISION  
:  
:

This is in response to the petition under 37 CFR 1.181, filed March 29, 2003, requesting that the application be forwarded to the Board of Patent Appeals and Interferences.

#### BACKGROUND

A review of the file history shows that this application was filed on July 19, 2000. A first Office action was mailed to applicant on October 31, 2000, in which claim 12 was rejected under 35 U.S.C. 112, second paragraph, as indefinite and incomplete; claims 1-4, 8-15 and 19-22 were rejected under 35 U.S.C. 102(e) and (b) as anticipated over Bradbury et al or Bazzano; and claims 1-22 were rejected under 35 U.S.C. 103(a) as unpatentable over Hoke in view of Orentreich et al. Applicant replied on February 7, 2001, including affidavits under 37 CFR 1.131 and 1.132 to overcome the rejections. No amendments to the claims were made.

The examiner mailed a Final Office action to applicant on March 27, 2001, rejecting claims 1-4, 8-10, 12 and 14 under 35 U.S.C. 102(b) as anticipated by Rajadhyaksha et al; claims 1-4, 8-10, 12-15 and 19-21 under 35 U.S.C. 102(b) as anticipated by Bazzano et al; and claims 1-22 under 35 U.S.C. 103(a) as unpatentable over Hoke in view of Orentreich et al. Applicant filed a Notice of Appeal and an Appeal Brief on April 30, 2001, responding to each of the rejections. An interview with the examiner was held on August 9, 2001, with both the examiner and applicant providing a record thereof. Some agreement for reconsideration appears to have been reached.

The examiner mailed a new non-final Office action to applicant on September 28, 2001 (remailed November 7, 2001), in which claims 5, 7, 16 and 18 were newly rejected under 35 U.S.C. 112, second paragraph as indefinite; claims 1-4, 8-10, 12-15 and 19-21 were rejected under 35 U.S.C. 102(b) as anticipated by Bazzano et al; claims 1, 3, 11-12, 14 and 22 were rejected under 35 U.S.C. 102(b) as anticipated by Bradbury et al; claims 1, 3, 12 and 14 were rejected under 35 U.S.C. 102(b) as anticipated by Partain III et al or Rajadhyaksha et al; claims 1-5, 7-11, 12-16

and 18-22 were rejected under 35 U.S.C. 103(a) as unpatentable over Hoke, alone, or in view of Bradbury et al or Rajadhyaksha et al; claims 11 and 22 were rejected under 35 U.S.C. 103(a) as unpatentable over Rajadhyaksha et al in view of Bazzano et al; and claims 6 and 17 were indicated allowable. Applicant replied on January 10, 2002, by canceling claims 6 and 17 and amending claims 1-2, 4-5, 7-10, 15-16 and 18 and replying to the rejections of record and supplying a new affidavit.

The examiner mailed a new Final Office action to applicant on May 9, 2002, in which claims 1, 3, 12 and 14 were rejected under 35 U.S.C. 102(b) as anticipated by Gibson; claims 1-2 and 12-13 were rejected under 35 U.S.C. 102(e) as anticipated by Crandall; claims 1-4 and 12-15 were rejected under 35 U.S.C. 102(e) as anticipated by Roentsch et al; claims 5, 7-10, 16 and 18-21 were rejected under 35 U.S.C. 103(a) as unpatentable over Roentsch et al in view of Crandall; and claims 11 and 22 were rejected under 35 U.S.C. 103(a) as unpatentable over Roentsch et al in view of Grollier et al. Applicant replied by filing a Notice of Appeal on June 21, 2002, and an Appeal Brief on June 28, 2002.

On February 20, 2003, the examiner mailed a new Final Office action to applicant setting forth a new rejection under 35 U.S.C. 112, first paragraph for lack of written description in the specification for claims 1-5, 7-16 and 18-22 which were considered to contain new matter. Claims 1, 3, 12 and 14 were rejected under 35 U.S.C. 102(b) as anticipated by Gibson; claims 1-4 and 12-15 were rejected under 35 U.S.C. 102(b) as anticipated by Bazzano; Claims 1-2 and 12-13 were rejected under 35 U.S.C. 102(b) as anticipated by Zupan; claims 2, 4-5, 7-10, 13, 15-16 and 18-21 were rejected under 35 U.S.C. 103(a) as unpatentable over Gibson in view of Bazzano or Schostarez; claims 11 and 22 were rejected under 35 U.S.C. 103(a) as unpatentable over Bazzano in view of Grolier et al.

Applicant filed this petition on March 29, 2003, seeking to have the application forwarded to the Board of Appeals for consideration.

## DISCUSSION

Applicant petitions to have the above identified application forwarded to the Board of Patent Appeals and Interferences based on the record as it presently exists. The prosecution history is noted above. It is noted that at least one rejection was initially made and repeated through the first three Office actions and then withdrawn (by not being repeated) and then reinstated in the last Office action. Also, each of the third, fourth and fifth Office actions contain new grounds of rejection. Some of these grounds may have been necessitated by applicant's amendments and/or arguments. Further consideration of affidavits under 37 CFR 1.131 and 1.132 appears to have been inconsistent with references being applied in later Office actions which would appear to have been disqualified by the affidavit under 37 CFR 1.131. Thus the issues in this application do not appear to have been fully developed by the examiner.

Applicant argues that the examiner is preventing consideration of this application by the Board of Appeals by consistently reopening prosecution, changing the grounds of rejection and refusing to write a "Reply Brief" (sic - Examiner's Answer). The Board of Appeals and Patent Interferences is a reviewing body and does not accept applications for review unless both parties have provided appropriate arguments in the form of an Appeal Brief and Examiner's Answer. Nor will the Board accept applications for review unless all of the issues have been fully developed and argued

by both parties. In this instance, although applicant has twice provided an Appeal Brief, the examiner discovered that all of the issues were not developed and therefor reopened prosecution. In some instances the new issues related to a new understanding of what was being claimed and how a reference could be applied, as evidenced by several new prior art rejections in the third, fourth and fifth Office actions and especially a new rejection under 35 U.S.C. 112, first paragraph, for lack of written description in the last Office action.

Applicant also argues that the examiner is attempting by her actions to alter the existing prosecution file and specifically requests that the examiner be prevented "from contesting the validity of any amendment, declaration or other submission entered into the file". There is no evidence that the examiner has in any way altered the papers in the application file or prohibited entry of any papers. All amendments submitted and all papers and affidavits have been properly entered and considered. It is required of the examiner to carefully consider and evaluate any affidavit submitted in an application and assess its relationship to any reference applied and/or any claim of unexpected results. The examiner has done this properly in the last Office action. It is an inherent examiner's duty to evaluate each and every affidavit and/or amendment entered in the file. This is what the term "examination" means. To ask that an examiner be prevented from examining (testing or contesting validity of an affidavit or amendment) violates the basic requirements of the examining position.

Applicant makes several other statements, the validity of which is questioned. Applicant states (page 3) that the examiner has disregarded M.P.E.P. guidelines in not acting on the (second) appeal within two months, but delayed for an entire year. Such is factually incorrect. The longest duration of time between an applicant submission and subsequent action, in any instance, was less than 8 months (6/28/02 to 2/20/03) and the delay in part was occasioned by a petition which was required to be decided before the examiner could act on the case. All other replies have been answered by a new Office action in four months or less from mail room receipt date.

Applicant also attempts to instruct the Board with respect to rejections not maintained by the examiner and to make its decision within 60 days from the filing date of this petition. Such attempted instruction is both inappropriate and improper and is disregarded.

The only action of the examiner which could be construed to be improper is the making Final the fourth and/or fifth Office action because of new rejections raised which were not necessitated by any amendment by applicant. It is especially noted that the fifth Office action contains several rejections over examiner cited new prior art. In view of M.P.E.P. 706.07(a) the last Office action should not have been made Final.

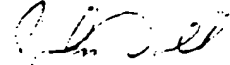
## DECISION

Applicants' petition is **DENIED** with respect to the request to forward the application to the Board of Appeals for consideration for the reasons set forth above.

However, although applicant did not request such, the finality of the last Office action is withdrawn in view of the new prior art rejections made which were not necessitated by applicant's reply immediately prior thereto. Applicant, however, remains under obligation to reply to that Office action within the time period set therein, or as may be extended under 37 CFR 1.136(a). Such reply may take the form of an amendment under 37 CFR

**1.112 or an Appeal Brief if applicant is of the opinion that all issues which should be considered by the Board have been fully developed.**

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

John Doll   
Director, Technology Center 1600

3

NOTE: Pursuant to Fed. Cir. R. 47.6, this order  
is not citable as precedent. It is a public order.

# **United States Court of Appeals for the Federal Circuit**

MISCELLANEOUS DOCKET NO. 738

IN RE W. ROY KNOWLES, M.D.,

Petitioner.

ON PETITION FOR WRIT OF MANDAMUS

Before RADER, GAJARSA, and LINN, Circuit Judges.

RADER, Circuit Judge.

## **ORDER**

W. Roy Knowles, M.D. petitions for a writ of mandamus to (1) direct the Director of the United States Patent and Trademark Office to forward his appeal of the examiner's actions to the Board of Patent Appeals and Interferences or mandate that the Director issue a notice of allowance or (2) have this court adjudicate the substantive merits of his application.

Knowles states that the examiner has issued six office actions, but refuses to "allow the Board of Patent Appeals & Interferences to review her work." Knowles petitioned the Director to have his application forwarded to the Board. In a well-explained decision, the Director informed Knowles of the steps that he must take in order to ready his application for Board review. Knowles was informed that he had to reply to the last office action by either filing an amendment or filing an appeal brief that responded to that office action or stated that he was of the opinion that all issues which should be considered by the Board had been fully developed. We note that Knowles,

just days before filing this petition, did file such an appeal brief.

The traditional use of the writ of mandamus in aid of appellate jurisdiction, 28 U.S.C. § 1651(a), has been to confine a trial tribunal to a lawful exercise of its prescribed jurisdiction or to compel it to exercise its authority when it is its duty to do so. Roche v. Evaporated Milk Ass'n, 319 U.S. 21, 26 (1943). A party who seeks a writ bears the burden of proving that it has no other means of attaining the relief desired, Mallard v. U.S. Dist. Court for the Southern Dist. of Iowa, 490 U.S. 296, 309 (1989), and that the right to issuance of the writ is "clear and indisputable." Allied Chemical Corp. v. Daiflon, Inc., 449 U.S. 33, 35 (1980).

Even assuming that we have mandamus jurisdiction over this matter, we decline to grant Knowles' petition. Knowles' complaints of impropriety are without basis. The Director informed Knowles of the steps he must take to obtain Board review and, indeed, he has taken a first step. Further, Knowles' request to have this court review the merits of his application is wholly inappropriate. Knowles' petition fails to meet either prong of the test for mandamus, i.e., he fails to show that his right to a writ is clear and indisputable and he fails to show that he has no other means to attain the relief desired.

Accordingly,

IT IS ORDERED THAT:

- (1) The petition for writ of mandamus is denied.
- (2) Any appeal filed by Knowles is dismissed.

---

See In re Makari, 708 F.2d 709 (Fed. Cir. 1983).

FOR THE COURT

7/30/03  
Date

Randall R. Rader  
Randall R. Rader  
Circuit Judge

cc: J. Mark Pohl, Esq.  
John Whealan, Esq.

s5

**FILED**  
**U.S. COURT OF APPEALS FOR**  
**THE FEDERAL CIRCUIT**

**AUG - 1 2003**

**IAN HORBALY**  
**CLERK**



4

**U.S. DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office**

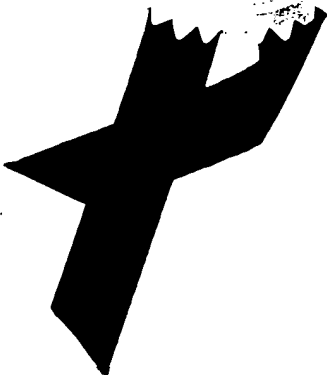
August 12, 2004

(Date)

**THIS IS TO CERTIFY** that the annexed documents are true copies from the records of the Patent Application Location and Monitoring (PALM) database.

By authority of the  
DIRECTOR OF THE UNITED STATES  
PATENT AND TRADEMARK OFFICE

*Kyra E. Abraham*  
Certifying Officer



Day : Wednesday

Date: 8/11/2004

Time: 17:52:29

## PALM INTRANET

## Content Information for 09/619142

Search Another: Application#   or Patent#

PCT /  /   or PG PUBS #

Attorney Docket #

Bar Code #

Appln Info	Contents	Petition Info	Atty/Agent Info	Continuity Data	Foreign Data
Date	Status	Code	Description		
08/11/2004		MEXIN	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)		
08/09/2004		EXIN	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)		
07/01/2004	123	MAPEA	MAIL EXAMINER'S ANSWER		
06/29/2004	122	APEA	EXAMINER'S ANSWER TO APPEAL BRIEF		
03/24/2004	197	J507	COURT PROCESSING TERMINATED		
08/01/2003		JA08	DECISION BY CAFC - DISMISSED		
07/18/2003		J511	APPELLANT'S BRIEF ON APPEAL		
07/18/2003	195	J502	APPEAL TO COURT OF APPEALS		
07/30/2003		FWDX	DATE FORWARDED TO EXAMINER		
07/18/2003	121	AP.B	APPEAL BRIEF FILED		
07/18/2003	120	N/AP	NOTICE OF APPEAL FILED		
07/18/2003		XT/G	REQUEST FOR EXTENSION OF TIME - GRANTED		
05/22/2003		PTDE	PETITION DECISION - DENIED		
03/29/2003		PET.	PETITION ENTERED		
	61	MCTFR	MAIL FINAL REJECTION (PTOL - 326)		

02/20/2003			
02/13/2003	60	CTFR	FINAL REJECTION
07/29/2002		PTGR	PETITION DECISION - GRANTED
06/27/2002		PET.	PETITION ENTERED
07/11/2002		FWDX	DATE FORWARDED TO EXAMINER
06/28/2002	121	AP.B	APPEAL BRIEF FILED
06/21/2002		APOH	REQUEST FOR ORAL HEARING
06/21/2002	120	N/AP	NOTICE OF APPEAL FILED
05/09/2002	61	MCTFR	MAIL FINAL REJECTION (PTOL - 326)
05/06/2002	60	CTFR	FINAL REJECTION
01/10/2002		AF/D	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED
01/24/2002		FWDX	DATE FORWARDED TO EXAMINER
01/10/2002	71	A...	RESPONSE AFTER NON-FINAL ACTION
11/07/2001		MNRES	MAIL NOTICE OF RESTARTED RESPONSE PERIOD
11/07/2001		NRES	LETTER RESTARTING PERIOD FOR RESPONSE (I.E. LETTER RE
09/28/2001	41	MCTNF	MAIL NON-FINAL REJECTION
09/28/2001	40	CTNF	NON-FINAL REJECTION
08/20/2001		FWDX	DATE FORWARDED TO EXAMINER
07/18/2001	121	AP.B	APPEAL BRIEF FILED
08/10/2001		EXIN	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)
07/05/2001		APBD	NOTICE -- DEFECTIVE APPEAL BRIEF
04/30/2001		APBI	DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED

04/30/2001		LET.	MISCELLANEOUS INCOMING LETTER
04/30/2001		AF/D	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED
05/04/2001		FWDX	DATE FORWARDED TO EXAMINER
04/30/2001	121	AP.B	APPEAL BRIEF FILED
04/30/2001	120	N/AP	NOTICE OF APPEAL FILED
03/27/2001	61	MCTFR	MAIL FINAL REJECTION (PTOL - 326)
03/26/2001	60	CTFR	FINAL REJECTION
02/12/2001		AF/D	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED
02/12/2001		AF/D	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED
02/21/2001		FWDX	DATE FORWARDED TO EXAMINER
02/12/2001	71	A...	RESPONSE AFTER NON-FINAL ACTION
02/12/2001		XT/G	REQUEST FOR EXTENSION OF TIME - GRANTED
10/31/2000	41	MCTNF	MAIL NON-FINAL REJECTION
10/27/2000	40	CTNF	NON-FINAL REJECTION
10/13/2000		PTGR	PETITION DECISION - GRANTED
07/19/2000		PET.	PETITION ENTERED
07/31/2000		SMAL	APPLICANT HAS FILED A VERIFIED STATEMENT OF SMALL E 37 CFR 1.27
07/19/2000		M844	INFORMATION DISCLOSURE STATEMENT (IDS) FILED
09/14/2000	30	DOCK	CASE DOCKETED TO EXAMINER IN GAU
09/06/2000	20	OIPE	APPLICATION DISPATCHED FROM OIPE
09/06/2000		C.AD	CORRESPONDENCE ADDRESS CHANGE

08/11/2000		SCAN	IFW SCAN & PACR AUTO SECURITY REVIEW
07/19/2000	19	IEXX	INITIAL EXAM TEAM NN

Appln Info	Contents	Petition Info	Atty/Agent Info	Continuity Data	Foreign Data
------------	----------	---------------	-----------------	-----------------	--------------

To go back use Back button on your browser toolbar.

Back to [PALM](#) | [ASSIGNMENT](#) | [OASIS](#) | [Home page](#)

5

**U.S. DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office**

August 12, 2004

(Date)

**THIS IS TO CERTIFY THAT THE ANNEXED IS A TRUE COPY FROM THE  
RECORDS OF THIS OFFICE OF THE FILE WRAPPER AND CONTENTS OF:**

**APPLICATION NUMBER: 09/619,142**

**FILING DATE: July 19, 2000**

**TITLE OF INVENTION: HAIR LOSS PREVENTION**

**INVENTORS: W. Ray Knowles**

By authority of the  
DIRECTOR OF THE UNITED STATES  
PATENT AND TRADEMARK OFFICE

*Kyra E. Aluham*

*Certifying Officer*







# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
09/619,142	07/19/2000	W. Ray Knowles	Knowles/HairLoss	1598

22925 7590 08/11/2004

PHARMACEUTICAL PATENT ATTORNEYS, LLC  
55 MADISON AVENUE  
4TH FLOOR  
MORRISTOWN, NJ 07960-7397

EXAMINER

KIM, VICKIE Y

ART UNIT	PAPER NUMBER
----------	--------------

1614

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Interview Summary

Application No.

09/619,142

Applicant(s)

KNOWLES, W. RAY

Examiner

Christopher S. F. Low

Art Unit

1614

All participants (applicant, applicant's representative, PTO personnel):

(1) Mark Pohl.

(3) \_\_\_\_\_.

(2) Christopher S. F. Low.

(4) \_\_\_\_\_.

Date of Interview: 09 August 2004.

Type: a) ☒ Telephonic b) ☐ Video Conference  
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.  
If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: none.

Identification of prior art discussed: none.

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant's representative answer to query regarding filing a reply brief was that a reply brief is going to be filed but probably not until next week at the earliest.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Christopher S. F. Low  
Examiner's signature, if required

## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

#### Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

#### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

#### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.